

requested. Claims 1-18 of the Damen patent do not anticipate claims 17-19 of the present application under sec. 102(e). Claim 17 is directed to the process of acylating the C(10) hydroxy group of a taxane with the additional step of treating the C(10) acylated taxane with an acylating agent to acylate the C(7) hydroxy group. Claim 18 of the present application is the same process as that of claim 17 wherein the C(10) acylated taxane is baccatin III. Sec 706.02 of the MPEP states that "[f]or anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." Nowhere in the Damen patent is it disclosed, either explicitly or impliedly, the additional step of acylating the C(7) hydroxy group in combination with the process of claim 1 of preparing baccatin III from 10-deacetyl baccatin III. Nor is the additional step of acylating the C(7) hydroxy group of any other C(10) acylated taxane disclosed in combination with the process of acylating the C10 position in the Damen patent.

Claim 19 of the subject application is also not anticipated under sec. 102(e) by claims 1-18 of the Damen patent. Claim 19 is directed to the process for the acylation of a C(10) hydroxy group of a taxane coupled with the additional step of esterifying the C(13) position of the C(10) acylated taxane with a β -lactam, oxazoline, oxazolidine, carboxylic acid, oxazolidine carboxylic anhydride, or isoserine derivative. Nowhere in the Damen patent is the step of esterifying the C(10) acylated taxane with a β -lactam, oxazoline, oxazolidine, carboxylic acid, oxazolidine carboxylic anhydride, or isoserine derivative either explicitly or impliedly disclosed.

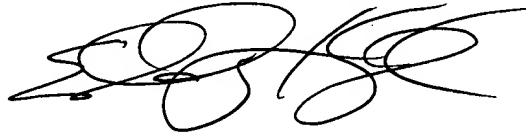
With respect to the rejection of claims 1-16 of the present application under 35 U.S.C. 102(e) as being anticipated by claims 1-18 of the Damen patent, the proper resolution of this rejection is a matter for an interference proceeding between the present application and the Damen patent. In furtherance of this end, Applicants are in the process of preparing the showing required by 37 CFR §1.608.

In view of the foregoing, favorable consideration and early allowance of appropriate pending claims is requested. Applicants respectfully request a three month extension of time to and including December 28, 1999 for filing a response to the Office action of June 28, 1999 in

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* this matter. Enclosed is a check in the amount of \$435.00. The Commissioner is hereby authorized to charge to Deposit Account No. 19-1345 any fees under CFR 1.16 and 1.17 which may be required during the entire pendency of this application.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'E. Hejlek', with a stylized, cursive script.

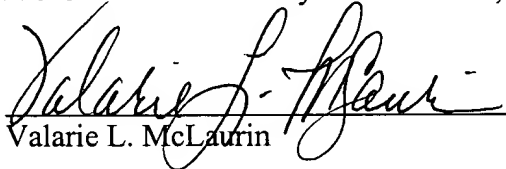
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CERTIFICATE OF MAILING

I certify that the foregoing AMENDMENT A, in the application of Robert A. Holton et al., Serial No. 09/063,477, filed April 20, 1998, is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on this **28th** day of **December, 1999**.


Valarie L. McLaurin

EJH/SJC/vlm
*Enclosure

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